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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,028	10/22/2003	James Russell Curtis	200314220-1	5010

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EXAMINER	
DAO, THUY CHAN	
ART UNIT	PAPER NUMBER
2192	

NOTIFICATION DATE	DELIVERY MODE
04/30/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/691,028	CURTIS ET AL.	
	Examiner	Art Unit	
	Thuy Dao	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02/12/08*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6, and 8-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6 and 8-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed on February 12, 2008.

2. Claims 1, 3-6, and 8-10 have been examined.

Response to Arguments

3. Applicant's arguments with respect to the rejection(s) of claims 1, 3-6, and 8-10 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Smith and further in view of Jong as applied in details below.

Claim Rejections – 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 6 and 8-10 are rejected because the claimed invention is directed to non-statutory subject matter: "A software program set on computer readable media", wherein said computer readable media can be transmission media as disclosed in the specification, page 6, paragraph 21.

Claim 6 amounts to Functional Descriptive Material: "Data Structures" representing descriptive material per se or "Computer Programs" representing computer listings per se.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium

encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. See MPEP 2106.

Dependent claims 8-10 do not cure the deficiencies as noted above, thus, also amount to Functional Descriptive Material: "Data Structures" representing descriptive material per se or "Computer Programs" representing computer listings per se.

Under the principles of compact prosecution, claims 6 and 8-10 have been examined as the Examiner anticipates the claims will be amended to obviate these 35 USC § 101 issues. For example (as a constructive proposal only), - - *A software program set embedded in one or more computer system[[on computer readable media]], said software program set comprising: ...* - - as disclosed in FIG. 1, computer system 13 and related text in page 4, lines 19-21.

Claim Rejections – 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 3-6, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,742,033 to Smith et al. (art made of record, hereinafter "Smith") in view of US Patent No. 6,192,403 to Jong et al. (art made of record, hereinafter "Jong").

Claim 1:

Smith discloses *a method comprising:*

launching an application on a user system (e.g., FIG. 2, blocks 200-206, col.7: 22-41);

tracking usage of said application so as to generate usage data on said user system (e.g., FIG. 2, blocks 202-208,col.7: 22-41);

accessing an update site from said user system (e.g., FIG. 3, blocks 220-230, col.7: 42-61);

transferring said usage data from said user system to said update site (e.g., FIG. 4, blocks 232-234, col.7: 62 – col.8: 7);

said update site prioritizing contents for said application at least in part as a function of said usage data (e.g., FIG. 4, blocks 234-242, col.7: 62 – col.8: 7); *and*

said update site presenting to a user a list of said contents as prioritized in said prioritizing step (e.g., col.4: 52-61; col.5: 1-12).

Smith does not explicitly disclose *said contents as updates for said application.*

However, in an analogous art, Jong further discloses *said contents as updates for said application* (e.g., col.1: 57-67; FIG. 8, blocks 3004-3006; FIG. 10, blocks 5006-5014).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Jong's teaching into Smith's teaching. One would have been motivated to do so to let a manufacturer of the application may provide

support to the user of the application through the adaptive monitor and support system as suggested by Jong (e.g., col.1: 57-67).

Claim 3:

The rejection of claim 1 is incorporated. Smith also discloses *said user selects one or more of said updates for said application* (e.g., col.7: 22-41; col.4: 52-61).

Claim 4:

The rejection of claim 3 is incorporated. Smith also discloses *said selected ones of said updates are installed so as to modify said application* (e.g., col.7: 42-61; col.5: 1-12).

Claim 5:

The rejection of claim 1 is incorporated. Smith also discloses *further development of said application is directed in part as a function of said usage data* (e.g., col.4: 52-61; col.7: 62 – col.8: 7).

Claim 6:

Smith discloses *a software program set embedded on one or more computer system, said software program set comprising:*

a usage data evaluator for receiving and evaluating raw usage data received provided by a user computer system; regarding a version of a software application installed thereon (e.g., FIG. 2, blocks 200-208, col.7: 22-41),

said usage data evaluator providing evaluated usage data; an update prioritizer for prioritizing contents available for said version at least in part as a function of said evaluated usage data (e.g., FIG. 3, col.7; 42-61);

a web interface for communicating with said user computer system via a browser on said user system as to present to a user of said computer system a list of said contents as prioritized by said prioritizer (e.g., FIG. 4, col.7: 62 – col.8: 7; col.4: 52-61; col.5: 1-12).

Smith does not explicitly disclose *said contents as updates for said application.*

However, in an analogous art, Jong further discloses *said contents as updates for said application* (e.g., col.1: 57-67; FIG. 8, blocks 3004-3006; FIG. 10, blocks 5006-5014).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Jong's teaching into Smith's teaching. One would have been motivated to do so to let a manufacturer of the application may provide support to the user of the application through the adaptive monitor and support system as suggested by Jong (e.g., col.1: 57-67).

Claim 8:

The rejection of claim 6 is incorporated. Smith also discloses *said web interface specifies, for at least some of said updates, advantages over said version of said application* (e.g., col.5: 1-12; col.7: 22-41).

Claim 9:

The rejection of claim 6 is incorporated. Smith also discloses *a usage-tracking module installed on said user computer system* (e.g., col.7: 62 – col.8: 7; col.4: 52-61).

Claim 10:

The rejection of claim 9 is incorporated. Smith also discloses *said usage-tracking module is integrated with said version of said application* (e.g., col.7: 42-61; col.5: 1-12).

Conclusion

8. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone/fax numbers are (571) 272 8570 and (571) 273 8570, respectively. The examiner can normally be reached on every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T Dao/

/Tuan Q. Dam/
Supervisory Patent Examiner, Art Unit 2192